



FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO CA 92138-0278

COPY MAILED

SEP 16 2009

OFFICE OF PETITIONS

In re Application	:
Rade Petrovic	:
Application No. 10/763,288	: DECISION ON APPLICATION
Filed: January 26, 2004	: FOR PATENT TERM ADJUSTMENT
Attorney Docket No. 50190-US-NP	:

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed April 6, 2009. Applicant requests that the determination of patent term adjustment be corrected from 73 days to 950 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008). In addition, applicant asserts entitlement to an additional period of adjustment of 272 days pursuant to 37 CFR 1.702(a)(2).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for

continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is DISMISSED.

On January 9, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 73 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

Applicants argue that an amendment was filed August 15, 2005 in response to a non-Final Office Action mailed July 5, 2005. A Final office action was then mailed November 3, 2005. However, in an Interview on December 20, 2005, the Examiner of record agreed to lift the finality of the November 3, 2005 Office Action and issue a new Action applying new art confirmed by an Interview Summary dated March 3, 2006. On September 13, 2006 a non-Final Office Action was mailed. Applicants argue further an entitlement to an additional 272 days of PTA pursuant to 37 CFR 1.702(a)(2) due to inaction by the PTO from December 15, 2005 (4 months after the August 15, 2005 response to office action filed by Applicant) until the mailing of the second non-Final office action on September 13, 2006.

Applicant's argument is not persuasive. 37 CFR 1.702(a)(2) provides that: Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

¹ PALM records indicate that the issue fee was paid on April 6, 2009.

Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

In this instance, the Office action mailed November 3, 2005 was mailed in response to and within four months of receipt of applicant's response filed August 15, 2005. The Office did not fail to take action in response to applicant's response within the time provided for in 37 CFR 1.702(a)(2). The fact that the Office subsequently mailed a further Office action withdrawing the finality of the November 3, 2005 Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on November 3, 2005. Accordingly, entry of an additional period of adjustment of 272 days for examination delay pursuant to 37 CFR 1.702(a)(2) is not warranted.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

In view thereof, the patent term adjustment at the time of mailing of the notice of allowance remains 73 days.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Examination Policy